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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,830	10/18/2001	Yawcheng Lo	82992PCW	7053

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Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/981,830	LO ET AL.	
	Examiner	Art Unit	
	MICHAEL BEKERMAN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14,21-23 and 30-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14,21-23 and 30-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 14, 21-23, and 30-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 14, this claim recites the limitation "means for placing the one or more digital images and the one or more correlated interest-specific advertisements on an output digital medium". The specification states that the images may be received from a storage medium, and that advertisements may be placed on that storage medium. The specification also states that the images may be re-formatted onto a

video CD or DVD at a location other than the kiosk. However, nowhere in the specification does it state that the images are placed, by the kiosk, onto the storage medium that the advertisements were placed on, nor are images placed on a disk by the kiosk. In fact, Examiner is confused after reading the specification as to why the kiosk would place images back on a storage medium that would already house the images to begin with. For the purposes of applying prior art, any disc-writing capability of a prior art reference will be taken as reading over a means for placing images on a disc. Claims 21-23 inherit this rejection through dependency from claim 14.

Regarding claims 30 and 31, these claims recite the limitations "means for placing the one or more digital images on an output digital image storage medium" and "means for placing the one or more interest-specific advertisements on the output digital image storage medium in a digital form". The specification states that the images may be received from a storage medium, and that advertisements may be placed on that storage medium. The specification also states that the images may be re-formatted onto a video CD or DVD at a location other than the kiosk. However, nowhere in the specification does it state that the images are placed, by the kiosk, onto the storage medium that the advertisements were placed on, nor are the images placed on a disc by the kiosk at all. In fact, Examiner is confused after reading the specification as to why the kiosk would place images back on a storage medium that would already house the images to begin with. For the purposes of applying prior art, any disc-writing capability of a prior art reference will be taken as reading over a means for placing images on a disc. Claim 32 inherits this rejection through dependency from claim 30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 14, 21-23, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko (U.S. Pub No. 2001/0044742) in view of King (U.S. Pub No. 2002/0055373), and further in view of Lipson (U.S. Patent No. 5,963,670).**

Regarding claims 14 and 22, Ko teaches extracting information from content on a disc (date/time information) (Paragraph 0035), correlating the extracted information to pre-determined advertisements (checking for updates based on the extracted date/time information) (Paragraphs 0039 and 0040), and placing the correlated advertisement on the disc (Paragraph 0041). The time information that is extracted from the disk is information related to the use of an electronic device. The computer taught by Ko in the cited sections is considered to be a kiosk computer. Ko further teaches an optical disc driving apparatus (Paragraph 0030) and loading the disc into a user terminal (Paragraph 0035), which reads on a platform for receiving a storage medium.

While Ko teaches determining appropriate advertisements based on content extracted from the disc, Ko does not appear to specify extracting specific image content. King teaches a method of matching advertisements (services such as "vacation opportunities") to interest-specific content information associated with picture files (Paragraphs 0030 and 0038). To match a vacation opportunity to an image, there must inherently be some form of classification performed. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to target advertisements based on any information that could be extracted from the disc of Ko, including the type of information taught by King. This would allow for better reception of the advertisement by the user.

While King teaches targeting advertisements based on information associated with images, neither Ko nor King appear to specify computer-analyzing images to receive such specific image content. Lipson teaches a method of computer-analyzing images to extract scene classification, face recognition, and biological motion (Column 2, Line 56 - Column 3, Line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer to extract such information from images. Not only would this eliminate unneeded human error, but should there be no information provided with an image in the system of King, information could be extracted and provided on the spot.

Regarding claim 23, the following is a definition for the term meta-data from Merriam-Webster online dictionary:

> Main Entry: **meta·da·ta**
> Pronunciation: \-'dā-tə, -'da- *also* -'dä-\
> Function: *noun plural but singular or plural in construction*
> Date: 1983
>
> : data that provides information about other data

Once information is extracted, that information is inherently meta-data as it is data that provides information about other data. However, King teaches using data associated with pictures (yet not necessarily extracted directly from pictures) to target advertising, and this data is considered to be metadata (Paragraphs 0030 and 0038). It would have been obvious to one having ordinary skill in the art at the time the invention was made

to target advertisements based on any information that could be extracted from the disc of Ko, including the type of information taught by King. This would allow for better reception of the advertisement by the user.

Regarding claim 21, Ko teaches image, video, and audio advertisements (Paragraphs 0031 and 0032).

Regarding claims 30-32, Ko teaches extracting information from content on a disc (date/time information) (Paragraph 0035), correlating the extracted information to pre-determined advertisements (checking for updates based on the extracted date/time information) (Paragraphs 0039 and 0040), and placing the correlated advertisement on the disc in a digital form (Paragraph 0041). The time information that is extracted from the disk is information related to the use of an electronic device. The computer taught by Ko in the cited sections is considered to be a kiosk computer. Ko further teaches an optical disc driving apparatus (Paragraph 0030) and loading the disc into a user terminal (Paragraph 0035), which reads on a platform for receiving a storage medium.

While Ko teaches a user computer kiosk terminal, Ko does not appear to specify that there is a printer (i.e. a means for printing) attached to the user computer kiosk terminal. However, Official Notice is taken that printers, attachable to computers of any kind, are old and well-known dating back well before Applicant's invention. In 1984, Hewlett Packard introduced both inkjet printers and laser printers for desktop computers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a printer on the computer of Ko. Not only would this allow a user to print any advertisements they desire, but it would also allow a user to print any other available information stored on the computer or disk should the user need any data in paper format.

While Ko teaches determining appropriate advertisements based on content extracted from the disc, Ko does not appear to specify extracting specific image content. King teaches a method of matching advertisements (services such as "vacation opportunities") to interest-specific content information associated with picture files (Paragraphs 0030 and 0038). To match a vacation opportunity to an image, there must inherently be some form of classification performed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to target advertisements based on any information that could be extracted from the disc of Ko, including the type of information taught by King. This would allow for better reception of the advertisement by the user.

While King teaches targeting advertisements based on information associated with images, neither Ko nor King appear to specify computer-analyzing images to receive such specific image content. Lipson teaches a method of computer-analyzing images to extract scene classification, face recognition, and biological motion (Column 2, Line 56 - Column 3, Line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a computer to extract such information from images. Not only would this eliminate unneeded human error, but should there be no information provided with an image in the system of King, information could be extracted and provided on the spot.

Response to Arguments

4. **Applicant argues** "Since neither Ko nor King teach the analysis of images to extract image information, Applicants fail to see how it would be obvious to substitute the image analysis methods of Lipson et al. into the method of Ko et al. and King et al.

to obtain a predictable result. Furthermore, Applicants fail to see what motivation one of ordinary skill in the art at the time of the invention would have had to combine the methods of providing advertising taught by Ko et al. and King et al. with the image analysis method of Lipson et al to produce the claimed invention". Examiner, however, has provided a motivation for combining the Ko and King references with Lipson. From the above rejection: "Not only would this eliminate unneeded human error, but should there be no information provided with an image in the system of King, information could be extracted and provided on the spot." In Applicant's most recent response, Applicant admits "While Applicant's agree that King teaches determining appropriate advertising based on the type of picture files that a user has entered, Applicants do not believe King teaches obtaining the information needed to make this classification through the analysis of extracted image information content". This is the reason that Examiner used Lipson in the 103 rejection. Applicant agrees that King teaches serving ads based on picture information, however the picture information isn't automatically gathered from the picture itself. For the reasons set forth in the rejection, it would be obvious to use old and well-known technology as taught by Lipson to gather data directly from the picture to use for targeting.

5. **Applicant further argues** "it is believed that the Examiner's rejection is based on improper hindsight reasoning". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. **Applicant argues** "Applicant's fail to see any reference to image, video, and audio advertisements in the indicated paragraphs". Paragraph 0032 of Ko recites "For instance, audio advertisements, audio and video advertisements, or other multimedia advertisements can be provided in order to more effectively advertise a product or service". Paragraph 0031 of Ko recites "The contents of an advertisement displayed on the advertisement display area has the form of a banner".

7. On a side note, the platform limitation in claim 14 is recited within a wherein clause. The following portions of the MPEP are relevant in regards to this type of claim language:

> MPEP 2114 states:
> While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a "**recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus**" if the prior art apparatus teaches all the structural limitations of the claim.
>
> MPEP 2106 (II) (C) states:
> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. **Language that suggests or makes optional but** does not require steps to be performed or **does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.** The following are examples of language that may raise a question as to the limiting effect of the language in a claim:
> (A) statements of intended use or field of use,
> (B) "adapted to" or "adapted for" clauses,
> (C) **"wherein" clauses**, or
> (D) "whereby" clauses.
> USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. **Limitations appearing in the specification but not recited in the claim should not be read into the claim.**

This is simply a notice to the Applicant that, while such limitations in the claims are not believed to have been ignored, a wherein clause does not function to actively limit the claim language.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Examiner, Art Unit 3622